

### REMARKS/ARGUMENTS

Claims 1-18 are pending in the present application. Claims 2, 8, 14, and 17 are canceled; claims 1, 3-4, 7, 9-10, 13, 15-16, and 18 are amended, and new claims 19-24 are added. Support for the amendment can be found in the specification at least on page 9, lines 16-22. Support for new claims 19, 21, and 23 can be found in the specification at least on page 2, lines 5-6, page 12, line 24, and figure 7. Support for new claims 20, 22, and 24 can be found in the specification at least on page 11, lines 11-13. Reconsideration of the claims is respectfully requested.

#### **I. Interview Summary**

Applicants thank Examiner Frantzy Poinvil for the courtesies extended to Applicants' representatives during the April 25, 2006 telephone interview. During the interview, Applicants' representatives discussed the distinction between the claims and the *Carlton-Foss* reference. Amendments to claim 1 to further clarify the distinction were also discussed. The Examiner agreed with the distinctions drawn by the Applicants between *Carlton-Foss* and features of amended claim 1, and indicated that the rejection of the claims based on this reference were overcome. The Examiner said that he would consider the proposed amendments for withdrawing the rejection based on *Carlton-Foss* upon the receipt of the present response. No agreement was reached as to other rejections under 35 U.S.C. § 102.

#### **II. 35 U.S.C. § 102, Anticipation**

The Examiner has rejected claims 1-18 under 35 U.S.C. § 102(e) as being anticipated by *Carlton-Foss*, Method and System for Processing and Transmitting Reverse Auction Information, United States Patent No. 6,647,373 B1 (issued, November 11, 2003), (hereinafter, "*Carlton-Foss*"). This rejection is respectfully traversed.

Applicants have amended independent claims 1, 7, and 13. *Carlton-Foss* does not anticipate the combined features of the amended claims. Claim 1 is representative of all independent claims in the group of claims 1-18, and in the amended form recites:

A method for facilitating a request for proposal (RFP) in an electronic marketplace, the method comprising the computer implemented steps of:

posting the RFP in an electronic marketplace;

communicating a portion of the RFP to at least one secondary marketplace participant from a plurality of primary and secondary marketplace

participants;

providing access to the RFP to the plurality of primary and secondary marketplace participants, wherein access to the RFP is utilized by the at least one secondary marketplace participant from the plurality of primary and secondary marketplace participants to generate a proposal for the portion of the RFP; and

posting the proposal in the electronic marketplace.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case, each and every feature of the presently claimed invention is not identically shown in the cited reference, arranged as they are in the claims.

The Examiner cites the following sections of *Carlton-Foss* in support of the rejection of claim 1:

The reverse auction system 10 includes a plurality of user interface devices 12, a network 14, an auction processor 16 and a database system 20. The user interface devices 12 are for bidders and requestors to make bids and requests. The user interface devices 12 may be any devices with input and output capabilities which allow a user of the system to communicate with a computer network including a terminal, or a personal computer. The network 14 may be any type of computer network including a private network such as a corporate intranet or a public network such as the World Wide Web. The auction processor 16 includes a processing unit 22 and an auction store 24 for storing the auction templates and other reverse auction system information. The database system 20 stores information about requests 26, bids 28 on those requests, users and their security information 30 for the reverse auction system 10, security information about who has permission to view which requests, and other relevant information. The database system 20 may be any one of many commercially available database management systems. Inside the database system 20, there is a bid database 28, a request database 26, and a user database 30 with a registration database 32. More databases may be added in alternative embodiments. The auction system 10 may be configured in other ways. For example, the auction processor 16 and database system 20 may be in the same computer, or alternatively, the various modules of the reverse auction system may have distributed components separately connected to the network. Also, in alternative embodiments, the database system 20 may be reconfigured, separating or combining the modules in configurations other than that shown in FIG. 1.

Once requestors have loaded the request database 26 with information about their requests, they can indicate that a request summary is ready for display to all potential bidders, or to a specified list of bidders. FIG. 15 shows a sample worksheet for requestors to review requests and bids. The reverse auction system 10 takes the information in the request database 26 and transforms it into a human readable format for viewing. Bidders are then able to view the request and submit proposals or other responses. The human readable presentation of a request preferably contains key identifying information such as the identification of the requestor and the deadline for submitting bids. The time the request is submitted is automatically stamped in its database record by the system.

Authorized bidders are able to view selected parts of the bids and respond with revised proposals. The human readable presentation of a bid preferably contains an electronic cover sheet with key identifying information such as the identification of the bidder, a picture of the proposed product uploaded to the database, pointers to the bidders' World Wide Web pages, and the date for submitting the bid.

The time the bid is received is automatically stamped in its database record by the system.

Upon accessing a public or private network and entering the part of the system that displays new requests on which the supplier is invited to submit a proposal, the bidder may perform a mouse click on a URL hot spot to display an electronic bid cover sheet. After completing the cover sheet, and storing the information by clicking on a submit button, bidders can click on another hot spot to begin entering as many line items as required to complete the bid. After storing the cover sheet or any line item entry, the bidder may modify it by clicking on another hot spot, modify the information, and store the changes by clicking on a submit button on the screen. Performing all of these operations on a single screen would not change the fundamental nature of the invention.

*Carlton-Foss*, col. 5, l. 32 – col. 6, l. 9; col. 6, ll. 14-22; col. 6, ll. 24-40.

In the cited sections, and as a whole, *Carlton-Foss* teaches the process of a reverse auction where multiple bidders can post proposals, or bids, for a requester's request. *Carlton-Foss* teaches a system for managing the various aspects of the bids, updating bid displays based upon the bidder's authorization, and managing the timing aspect to the bids. However, *Carlton-Foss* does not teach the feature, "providing access to the RFP to the plurality of primary and secondary marketplace participants" as claimed in amended claim 1.

The feature of former claim 2, "direct access to the RFP by the primary and secondary market participants," now canceled and merged in the amended claim 1, is not taught by *Carlton-Foss*. The Examiner further cites to the following figures in *Carlton-Foss* as teaching this claimed feature:

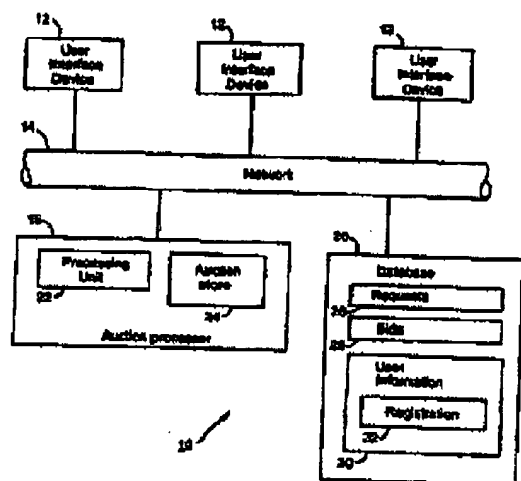


FIG. 1

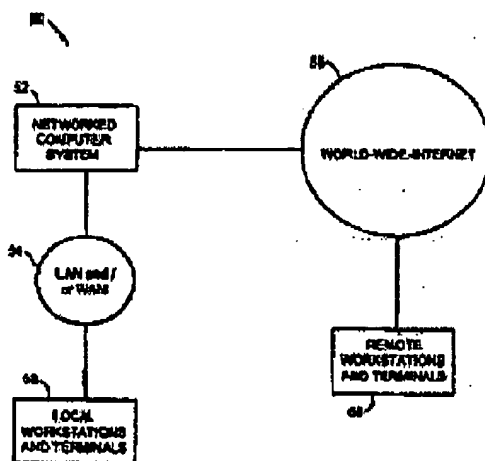


FIG. 2

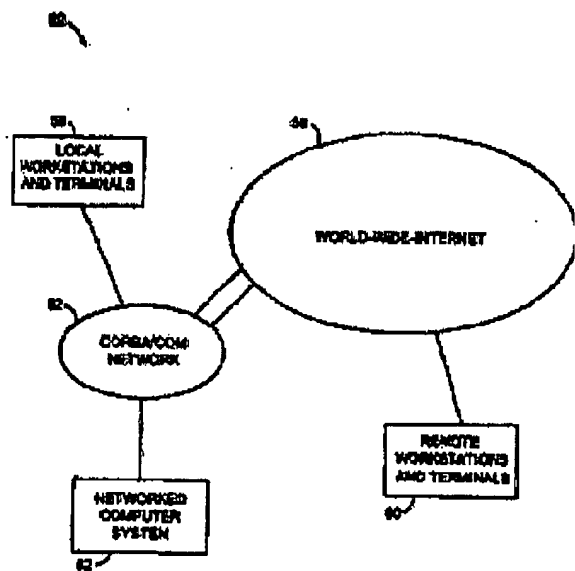


FIG. 3

Carlton-Foss, figures, 1-3.

In the cited figures, *Carlton-Foss* only shows a plurality of workstation terminals indicating that a number of bidders may be able to access the reverse auction system. However, in these figures, *Carlton-Foss* provides no distinction between workstation terminals as being used by a primary market participant or a secondary market participant. Further, *Carlton-Foss*'s entire disclosure provides no reason to distinguish the workstations in this manner. *Carlton-Foss*' method and system for reverse auction does not depend on such a distinction between the bidders. *Carlton-Foss* teaches maintaining "specified list of bidders," *Carlton-Foss*, col. 5, l. 66; and that the "authorized bidders are able to view selected parts of the bids and respond to revised proposals," *Id.*, col. 6, ll. 14-16. However, neither of these teachings translates into the separation of bidders by the nature of the markets in which they participate. Therefore, the *Carlton-Foss* disclosure including the cited *Carlton-Foss* figures contains no teachings of primary and secondary market participants as claimed in claim 1.

Therefore, *Carlton-Foss* does not teach the feature, "providing access to the RFP to the plurality of primary and secondary marketplace participants" of claim 1. Because *Carlton-Foss* lacks any disclosure of the primary and secondary nature of the markets and marketplace participants, *Carlton-Foss* also cannot teach the feature, "wherein the access to the RFP is utilized by the at least one secondary marketplace participant from the plurality of primary and secondary marketplace participants to generate a proposal for the portion of the RFP" as claimed in amended claim 1. Amended claim 1 particularly recites a secondary marketplace participant, utilizing the access to the RFP provided in the method of claim 1, for generating a proposal only for a portion of the RFP in question. *Carlton-Foss* in the entire disclosure discloses no secondary marketplace, no secondary marketplace participant, and no partial response to a RFP from a secondary marketplace participant.

For the same reasons, *Carlton-Foss* also does not teach the feature, "communicating a portion of the RFP to at least one secondary marketplace participant from a plurality of primary and secondary marketplace participants" as claimed in amended claim 1. Again, this feature of amended claim 1 illustrates the distinction between primary and secondary marketplace participants, and their distinct access, roles, and responses towards the RFP. Particularly, *Carlton-Foss* lacks any disclosure of the communication of a portion of the RFP to a secondary marketplace participant as recited in claim 1.

Consequently, *Carlton-Foss* does not teach every element of the claimed invention arranged as they are in claim 1. Therefore, *Carlton-Foss* does not anticipate claim 1 under 35 U.S.C. § 102(e). Because amended independent claims 7 and 13 incorporate features similar to those in claim 1, *Carlton-Foss* also does not anticipate claims 7 and 13. *Carlton-Foss* also does not anticipate claims 3-6, 9-12, 15-16, and 18 at least by virtue of their dependence from these amended independent claims. Therefore, the rejection of claims 1-18 has been overcome.

**III. Conclusion**

It is respectfully urged that the subject application is patentable over *Carlton-Foss* and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 5/18/06

Respectfully submitted,



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